

1247-0796-0V PCT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JEAN-LOUIS BRAVET ET AL : EXAMINER: PAULRAJ, C.
SERIAL NO: 09/147,813 :
FILED: AUGUST 31, 1999 : GROUP ART UNIT: 1773
CPA FILED: APRIL 5, 2001

AEJ
24 / 11/20/02

FOR: PLASTIC GLAZING, IN
PARTICULAR FOR MOTOR
CAR AND METHOD FOR
MAKING SAME

RECEIVED
NOV 14 2002
TC 1700

REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

The following is a Reply Brief in reply to the Examiner's Answer dated October 22, 2002 (Answer).

Under "(7) Grouping of Claims," the Examiner incorrectly finds that the rejection of Claims 40-65 stand or fall together because the Appeal Brief (Brief) does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof.

In reply, the Brief states that "[t]he claims all stand or fall separately" (Brief at 4) and moreover, these claims have been argued separately (Brief at *passim*).

Appellants affirm all that has been previously argued in the Brief. The remainder of this reply brief replies to the "(11) Response to Argument" (Answer at 7-14).

The Examiner finds that “[o]ne skilled in the art, when looking to the prior art for a specific teaching, . . . would not necessarily have to incorporate *all other features* (emphasis by Examiner) disclosed in a prior art reference unless those features are considered integral to the practice of that teaching” (Answer at 8).

In reply, while that may be true in some cases, it is not true here. The art as a whole suggests that glass substrates and plastic substrates are not simply interchangeable but that other factors must be considered. The Examiner has not considered any of these factors.

The Examiner finds that one skilled in the art would have found it obvious to make a cost-benefit analysis to determine whether or not the increased costs associated with using a plastic substrate outweigh the benefits derived from the lower weight associated with a plastic substrate (Answer at 9).

In reply, if such a cost-benefit analysis were made, the result would be, as suggested by Appellants in the Brief, replacing the glass substrate of Motter et al with not only the plastic substrate of Hirmer, but also Hirmer’s relatively thin sheet which, as pointed out in the Brief, has a thickness which is greater than both the presently-recited at least one skin layer and scratch-resistant layer.

The Examiner finds that “in a somewhat non sequitur statement,” Appellants admit that the Examiner may have a point so long as weight was the only factor in substituting a glass substrate with a plastic substrate (Answer at 9).

In reply, Appellants’ statement is not a non sequitur because it is clear that in this art, weight would be only one of many factors considered.

The Examiner finds that with regard to the rejections of Claims 41, 42, 43, 44, 45, 49, 52, 62, and 63, Appellants simply assert patentability without providing any reasons in support (Answer at 11).

In reply, Appellants' argument of separate patentability of these claims is legally sufficient. *In re Beaver*, 13 USPQ2d 1409 (Fed. Cir. 1989).

With regard to Claims 46, 47, 48, 50 and 51, the Examiner simply concludes that the prior art provides motivation to combine the cited prior art (Answer at 11), without making any fact-finding analysis to support the conclusion.

The Answer is in violation of 37 C.F.R. § 1.193(a)(2) by including a new ground of rejection in that the Examiner now relies additionally on an article by Charrier to support the rejection of Claims 53-61 (Answer at 12)¹. The Board should ignore this reference.

Nevertheless, even though injection molding machines may produce articles varying relatively greatly in size, it does not mean that one skilled in the art would have applied the disclosure in Tatebayashi to solve any problem with regard to motor vehicle windows. Relying on Charrier, the Examiner finds that it would not be unreasonable for one skilled in the art to expect that Tatebayashi's process can be used to make products larger in size than the 50 mm diameter disclosed in the example therein (Answer at 12).

In reply, this finding puts the cart before the horse! The Examiner has not provided the requisite motivation to make an automobile window according to a process disclosed for making much smaller windows, such as for meters or clocks. The issue is not whether given Tatebayashi and a goal for making automobile windows, would one skilled in the art then expect that Tatebayashi's process could be used.

The Examiner's citation of the *Rinehart* and *Gardner* decisions (Answer at 12-13) are inapposite, because every issue of obviousness must be evaluated on a case-by-case basis.

¹That the new prior art is not listed in the statement of the rejection is irrelevant; reliance thereon is all that is necessary. "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." *In re Hoch*, 166 USPQ 406, 407 n.3 (CCPA 1970). See also MPEP 706.02(j).

Cases with particular fact situations are no substitute for evidence, missing in this case, that would support a finding that one skilled in the art would look to subject matter regarding meter and clock windows to solve a problem regarding automobile windows.

Regarding the Examiner's finding that separate reasons have not been advanced for various claims (Answer at 13-14), see *Beaver, supra*.

Appellants continue to submit that all of the rejections should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Harris A. Pitlick
Registration No. 38,779



22850

(703) 413-3000
Fax #: (703) 413-2220
NFO:HAP:kst

I:\atty\HAP\12470796-rb.wpd